

### Remarks/Arguments

The foregoing amendments in the specification and claims are of formal nature, and do not add new matter.

Prior to the present amendment, claims 39-51 were pending in this application and were rejected on various grounds. Claims 47 and 48 have been cancelled without prejudice. The rejection to the remaining claims is respectfully traversed.

### Priority

2) The Examiner states that Applicants are only entitled to the 2/22/00 priority of the PCT/US00/04414. It is noted for the record that the "Stimulatory activity in mixed lymphocyte reaction (MLR)" Assay, Example 74, was first disclosed in US Application Serial No. 60/100,858 filed September 17, 1998. Since the results of this assay establish patentable utility for the invention claimed in this application, the effective filing date of the present application is September 17, 1998.

### Specification

3. The specification has been objected to for containing embedded hyperlink and/or other form of browser-executable code. The foregoing amendment, which deleted all embedded hyperlinks, is believed to overcome this objection.

### Claim Rejections – 35 U.S.C. § 112

4-5a) Claims 39-51 are rejected under 35 USC § 112, second paragraph, as being indefinite. Since PRO217 is a soluble protein, references to the "extracellular domain" are indefinite. Cancellation of claims 47-48, without prejudice or disclaimer, and the current claim amendments which remove all references to the extracellular domain, are believed to overcome this rejection. Accordingly, the present rejection is believed to be moot, and should be withdrawn.

6-8. Claims 39-43, 50-51 were rejected under 35 USC § 112, first paragraph, as allegedly not being enabling and for alleged lack of sufficient written description for the genus claimed.

The present claim amendments add the recitation that the claimed nucleic acid molecules encode polypeptides "capable of stimulating proliferation of T-lymphocytes." Applicants submit that the specification provides ample enablement for polypeptides defined in the genus based on the data provided in Example 74. Coupled with the general knowledge in the art at the time of the invention, Applicants submit that the present application provides sufficient guidance to one skilled in the art to make and use the invention without undue experimentation. As the M.P.E.P. states, "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-charge cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff. sub nom.*, *Massachusetts Institute of Technology v A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. cir. 1985) M.P.E.P. 2164.01.

The Examiner has acknowledged enablement for a similar genus reciting a different biological activity.

Hence, the present rejection to amended claims 39-43 should be withdrawn.

#### Claim Rejections - 35 USC § 102

9-11) Claims 39-43 and 44-49 were rejected under 102 (a) as allegedly being anticipated by Hsieh *et al.* (Nature 398: 431-36, 1999) which discloses polypeptide with 99.7% amino acid sequence identity to SEQ ID NO: 4 of the present application.

As discussed above, the "stimulation of proliferation of T-lymphocytes assay" was first disclosed in US Application no. 60/100,858 filed on September 17, 1998, whose priority is claimed in the present application. Thus, the effective filing date of the present application is September 17, 1998.

According to the Office action, the effective reference date of Hsieh is 1999 which is after the effective filing date of the present application. Thus, Applicants submit that Hsieh is not a proper prior art reference under § 102(a).

Hence, Applicants respectfully request withdrawal of this rejection.

12) Claims 39-43 and 44-49 were rejected under 102 (b) as allegedly being anticipated by Brewer *et al.* (WO 98/54963; published 12/10/1998) which discloses a polypeptide approximately 99% identical to polypeptide of SEQ ID NO: 4 of the present application.

However, as discussed above, the effective filing date of the present application is September 17, 1998. According to the Office action, the effective reference date of Brewer is 12/10/1998 which is after the effective filing date of the present application.

Thus, Applicants submit that Brewer is not proper prior art under § 102(b) or 102(a) and respectfully request withdrawal of this rejection.

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#### Claim Rejections - 35 USC § 103

11) Claims 44-49 were rejected under 103 (a) as allegedly being obvious over Hsieh *et al.* (Nature 398: 431-36, 1999) which discloses a polypeptide with 99.7% (differs by one amino acid) sequence identity to SEQ ID NO: 4 of the present application.

13) Claims 44-49 were rejected under 103 (a) as allegedly being obvious over Brewer *et al.* (WO 98/54963; pub.12/10/1998) which discloses a polypeptide approximately identical (differs by 2 amino acids) to the polypeptide of SEQ ID NO: 4 of the present application.

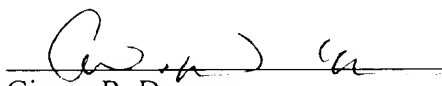
Both the references cited above, as discussed before, have effective reference dates (1999 for Hsieh and 12/10/1998 for Brewer) after the effective filing date of the present application, namely September 17, 1998. Thus, Applicants submit that neither Hsieh nor Brewer are proper prior art under § 103(a) and respectfully request withdrawal of this rejection.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1618P2C7). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: March 13, 2003

  
Ginger R. Dreger,  
Reg. No. 33,055

**HELLER EHRMAN WHITE & McAULIFFE LLP**

**Customer No. 35489**

275 Middlefield Road  
Menlo Park, California 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

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